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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,299	12/18/2001	Koichi Iijima	011660	4119

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT PAPER NUMBER

2192

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/017,299

Applicant(s)

IIJIMA, KOICHI

Examiner

Hoang-Vu A. Nguyen-Ba

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-10 and 12-20 is/are allowed.
- 6) ☒ Claim(s) 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to amendment filed February 15, 2005.
2. Claims 1-20 are pending.

### ***Response to Amendments***

3. Per Applicant's request, claim 20 has been added; claims 1-4, 6-14, 16 and 18-19 have been amended.
4. The objection to the drawings is withdrawn in view of Applicant's amendment to Figure 11 to correct an identified minor informality.
5. The objection to the abstract of the disclosure is withdrawn in view of Applicant's amendments to the abstract to correct the identified minor informalities.
6. The objection to claims 4, 12 and 14 is withdrawn in view of Applicant's amendments to these claims to correct the identified minor informalities.
7. The rejection of claims 1-3, 6-13, 16 and 18-19 under 35 U.S.C. § 112, second paragraph as being indefinite is withdrawn in view of Applicant's amendments to these claims to clearly point out and distinctly claim the subject matter which applicant regards as his invention.

### ***Response to Arguments***

8. Applicant's arguments, see Remarks, pp. 13-16, filed February 15, 2005, with respect to claims 1-20 have been fully considered and are persuasive. The rejection of these claims under 35 U.S.C. § 102(e) as being anticipated by Kawanabe has been withdrawn.

### ***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 11 is rejected under 35 U.S.C. 101 as being directed to nonstatutory subject matter.

Statutory subject matter requires two things:

(1) it must be in the “useful arts,” U.S. Const., art. I, § 8, cl. 8, which is equivalent to the modern “industrial” or “technological arts,” defined by Congress in the four categories of “process, machine, manufacture, or composition of matter” in 35 USC § 101; and if it is,

(2) it must not fall within one of the exceptions for “laws of nature, physical phenomena and abstract ideas.”

Under the most recent Federal Circuit cases, transformation of data by a machine (e.g., computer) is statutory subject matter provided the claims recite a “practical application, which produce[s] a useful, concrete and tangible result.” State St. Bank & Trust Co. v. Signature Fin. Group, Inc. 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600-01 (Fed. Cir. 1998).

In this instance, the language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete and tangible result to form the basis of statutory subject matter under 35 USC § 101.

Furthermore, the Office’s interpretation of this claim is that it does not expressly or implicitly require performance of any of the steps by a machine such as a general-purpose digital computer. Structure will not be read into the claims for the

purpose of the statutory subject matter analysis even though the steps might be capable of being performed by a machine.

On this basis, claim 11 is rejected under 35 USC § 101 as being directed to nonstatutory subject matter.

### ***Allowable Subject Matter***

11. Claims 1-10 and 12-20 are allowed.
12. The following is an examiner's statement of reasons for allowance:

The prior art of record, Kawanabe, taken individually or in combination, fails to teach or suggest the specific comparisons performed according to the principles of the instant invention recited in claims 1, 10 and 20.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

13. Claim 11 would be allowable if rewritten to direct the claim to statutory subject matter.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hoang-Vu A. Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 7:15 – 17:45.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Tuan Dam can be reached at (571) 272-3695.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANTONY NGUYEN-BA  
PRIMARY EXAMINER**

Art Unit 2192

June 2, 2005